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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FISCHER, ANDREW J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 01/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/923,846

Applicant(s)

ITAKURA ET AL.

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 56-63 and 72 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☐ Claim(s) 56-63 and 72 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 07 August 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. Applicants' amendment filed August 16, 2004, Paper No. 17, ("Applicants' Second Response") is acknowledged. Accordingly, claims 56-62 and 72 remain pending.
2. However, because Applicants have amended the claims in Applicants' Second Response such that this application now contains inventions directed only towards a single invention, a restriction is now improper. Therefore, the restriction as set forth in the previous Office Action (mailed July 19, 2002) is hereby withdrawn. Should Applicants amend any claim or add claim(s) such that this application would then contain claims directed towards two (2) or more distinct and independent inventions, an additional restriction may be required at that time. See MPEP §811.03.
3. The Examiner notes that the Election of Species as set forth in the Office Action mailed July 19, 2002 has also been withdrawn. See the First Non Final Office Action mailed November 7, 2004, Paper No. 8 ("First Non Final Office Action"), paragraph No. 4.
4. The Petition to Revive filed under 37 C.F.R. § 1.137(b) on August 16, 2004 has been granted. See the decision, Paper No. 18, mailed September 1, 2004 which grants Applicants' petition.
5. The drawings filed in Applicant's First Amendment, Figure 38, has not been entered. The USPTO does not enter conditional amendments. See Page 5 of Applicants' Remarks filed in Applicants' Second Response.
6. All references in this Office Action to the capitalized versions of "Applicants" refers specifically the Applicants of record. References to lower case versions of "applicant" or

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“applicants” refers to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” in this Office Action refers to the Examiner of record while reference to or use of the lower case version of “examiner” refers to examiner(s) generally.

7. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologies for these errors.

Drawings

8. The drawings are objected to under 37 C.F.R. §1.83(a). The drawings must show every feature of the invention specified in the claims. No new matter allowed. The following must be shown or the features canceled from the claims:

- a. The “modifying said amount need to pay for the on-line purchase according to the value parameter” as recited in claim 56.
- b. The “order response including an amount needed to pay for the on-line purchase” as recited in claim 56.
- c. The “checking the value of the parameter” as recited in claim 56.

Claim Rejections - 35 USC §112 2nd Paragraph

9. The following is a quotation of the 2nd paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 56-63 and 72 are rejected under 35 U.S.C. §112, 2nd paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow.

11. In claim 56, the phrase “and stored in the database” is indefinite since appears to be modifying the term “user.” Applicants are reminded that “[a] claim must be read in accordance with the precepts of English grammar.” *In re Hyatt*, 708 F.2d 712, 714, 218 USPQ 195, 197 (Fed. Cir. 1983). In reference to all claim limitations (and the English grammar within those claims in particular), Applicants are also reminded that “semantic indefiniteness of claims is not rendered unobjectionable merely because it *could* have been corrected. [Emphasis in original.]” *Allen Engineering Corp. v. Bartell Industries Inc.*, 299 F.3d 1336, 1349, 63 USPQ2d 1769, 1776 (Fed. Cir. 2002) (citations and quotations omitted).

12. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112 2nd paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

Claim Rejections - 35 USC §102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 56-63 and 72, as understood by the Examiner, are rejected under 35 U.S.C. 102(e) as being anticipated by Harms et. al. (U.S. 6,070,147). Harms discloses the claimed invention including basing the discount the frequency of accessing messages (purchasing messages).

Claim Rejections - 35 USC §103

15. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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16. Claims 56-63 and 72, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Harms.¹ It is the Examiner's principle position that the claims are anticipated because the value parameter is inherent in the discount.

However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Harms to include the value parameter as the discount. Such a modification would have rewarded more customers.

17. The Examiner concludes that Applicants have decided not to be their own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Office Action,² the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only have Applicants not pointed to definitional statements in their specification or prosecution history, Applicants have also not pointed to a term or terms in a claim with which to draw in those statements³ with the required clarity, deliberateness, and precision.⁴ Third, after receiving express notice in the previous Office Action of the Examiner's

¹ See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

² See the First Non Final Office Action, Paragraph No. 16.

³ "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

⁴ "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158

position that lexicography is not invoked,⁵ Applicants have not pointed out the “supposed errors” in the Examiner’s position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicants have not argued lexicography is invoked). Finally and to be sure of Applicants’ intent, the Examiner also notes that Applicants have declined the Examiner’s express invitation⁶ to be their own lexicographer.⁷ Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process (and unless expressly noted otherwise by the Examiner), the heavy presumption in favor of the ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).⁸ The Examiner now relies heavily and extensively on this interpretation.⁹

F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

⁵ See again the First Non Final Office Action, Paragraph No. 16.

⁶ *Id.*

⁷ The Examiner’s requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner’s requirements were simply an express request for clarification of how Applicants intend their claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicants was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO’s goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO’s The 21st Century Strategic Plan, February 3, 2003 available at www.uspto.gov/web/offices/com/strat21/index.htm (last accessed December 22, 2004).

⁸ See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (“In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification”) (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

18. To the extent that the Examiner's interpretations are in dispute with Applicants' interpretations, the Examiner hereby adopts the following definitions—under the broadest reasonable interpretation standard—in all his claim interpretations.¹⁰ Moreover, while the following list is provided in accordance with *In re Morris*, the definitions are a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language.¹¹ Finally, the following list is not intended to be exhaustive in any way:

Server: “2. On the Internet or other network, a computer or program that responds to commands from a client.” Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.¹² **Client:** “3. On a local area network or Internet, a computer that accesses shared network resources provided by another computer (called a server).” *Id.* **Computer:** “Any machine that

⁹ See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability [Emphasis added.]”

¹⁰ While most definition(s) are cited because these terms are found in the claims, the Examiner may have provided additional definitions to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

¹¹ See e.g. *Brookhill-Wilk 1 LLC v. Intuitive Surgical Inc.*, 334 F.3d 1294, 1300, 67 USPQ2d 1132, 1137 (Fed. Cir. 2003) (abstract dictionary definitions are not alone determinative; “resort must always be made to the surrounding text of the claims in question”).

¹² Based upon Applicants' disclosure, the art of record, and the knowledge of one of ordinary skill in this art as determined by the factors discussed in MPEP §2141.03 (where practical), the Examiner finds that the *Microsoft Press Computer Dictionary* is an appropriate technical dictionary known to be used by one of ordinary skill in this art. See e.g. *Altiris Inc. v. Symantec Corp.*, 318 F.3d 1363, 1373, 65 USPQ2d 1865, 1872 (Fed. Cir. 2003) where the Federal Circuit used the *Microsoft Press Computer Dictionary* (3d ed.) as “a technical dictionary” to define the term “flag.” See also *In re Barr*, 444 F.2d 588, 170 USPQ 330 (CCPA 1971)(noting that its

does three things: accepts structured input, processes it according to prescribed rules, and produces the results as output.” Id.

Database “A file composed of records, each containing fields together with a set of operations for searching, sorting, recombining and other functions.” Id.

Data “Plural of the Latin datum, meaning an item of information. In practice, data is often used for the singular as well as plural the form of the noun.” Id.

Electronic Commerce: “Commercial activity that takes place by means of connected computers. Electronic commerce can occur between a user and a vendor through an online information service, the Internet, or a BBS, or between a vendor and customer computers through electronic data interchange.” Id.

Internet “The worldwide collection of networks and gateways that use the TCP/IP suite of protocols to communicate with one another. At the heart of the Internet is a backbone of high-speed data communication lines between major nodes or host computers, consisting of thousands of commercial, government, educational, and other computer systems, that route data and messages.” Id.

Network: “A group of computers and associated network devices that are connected by communications facilities.” Id.

Relational Model “A data model in which the data is organized in relations (tables). This is the model implemented in most modern database management systems.” Id.

Relational Database “A database or database management system that stores information in tables—rows and columns of data—and conducts searches by using data in specified columns of

appropriate to use technical dictionaries in order to ascertain the meaning of a term of art) and

one table to find additional data in another table. In a relational database, the rows of a table represent records (collections of information about separate items) and the columns represent fields (particular attributes of a record). In conducting searches, a relational database matches information from a field in one table with information in a corresponding field of another table to produce a third table that combines requested data from both tables. . . . Microcomputer database products typically are relational databases. *Compare* flat-file database, inverted-list database.”

Id. **Record** “A data structure that is a collection of fields (elements), each with its own name and type. Unlike an array, whose elements all represent the same type of information and are accessed using an index, the elements of a record represent different types of information and are accessed by name. A record can be accessed as a collective unit of elements, or the elements can be accessed individually. Id. **Table** “1. In programming, a data structure usually consisting of a list of entries, each entry being identified by a unique key and containing a set of related values. A table is often implemented in an array of records, a linked list, or (in more primitive languages) several arrays of different data types all using a common indexing scheme. 2. In relational databases, a data structure characterized by rows and columns, with data occupying or potentially occupying each cell formed by a row-column intersection. The table is the underlying structure of a relation.” Id.

Information “2 a . . . (3): FACTS, DATA . . .” Merriam-Webster’s Collegiate Dictionary, 10th Edition, Merriam-Webster Inc., Springfield, M.A., 1997.

19. To begin with, the Examiner takes Official Notice that in a conventional purchase transaction(s), the customer makes an offer to a merchant at e.g. the checkout counter. The

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merchant either excepts or rejects the offer. If the merchant accepts the offer, the customer pays for the item and the merchant give the item to the customer before walking out of facility. See *e.g.* White, James J., and Summers, Robert S., Uniform Commercial Code, 4th Ed. pp 25-39 (“White and Summers”). If fact, the Examiner finds that all of the scenarios, examples, and legal principles disclosed in White and Summers are old and very well known in this art. (White and Summers is cited in its entirety.)

20. Additionally, the Examiner notes that “the PTO and the CCPA acknowledged product-by-process claims as an exception to the general rule requiring claims to define products in terms of structural characteristics.” *Atlantic Thermoplastics Co. v. Faytex Corp.*, 970 F.2d 834, 845, 23 USPQ2d 1481, 1490 (Fed. Cir. 1992) (hereinafter “*Atlantic Thermoplastics v. Faytex I*”). Furthermore, the Federal Circuit “acknowledges that it has in effect recognized . . . product-by-process claims as exceptional.” *Atlantic Thermoplastics v. Faytex I*, 970 F.2d at 847, 23 USPQ2d at 1491.

Because of this exceptional status, the Examiner has carefully reviewed the claims and it is the Examiner’s position that claims 56-62 and 72 *do not* contain any product-by-process limitations whether in a conventional format or otherwise. If Applicants disagree with the Examiner, the Examiner respectfully requests Applicants in their next response to expressly point out any product-by-process claim(s) and their limitations so that they may be afforded their exceptional status and treated accordingly. Applicants are reminded that “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself.” *In re Thorpe*, 777 F.2d 695, 697, 227 USPQ 964, 966 (Fed. Cir.

1985) (citations omitted).¹³ Failure by Applicants in their next response to also address this issue in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered intent by Applicant(s) *not* to recite any product-by-process limitations. Unless expressly noted otherwise by the Examiner, the preceding discussion on product-by-process principles applies to all examined claims currently pending.

Response to Arguments

21. Applicant's "Arguments" filed in Applicants' Second Response have been fully considered but they are not persuasive.

Drawings

22. Applicants arguments with the respect to the drawings are not persuasive. Applicants state 35 U.S.C. 113 and MPEP 601.01(f) and argue that "a drawing is not necessary for the understanding of the invention as defined by the claims."¹⁴ The Examiner agrees with the statutory requirements of 35 U.S.C. §113 and notes that the Examiner is required to follow these requirements. See *e.g. In re Mother Tucker's Food Experience, Inc.*, 925 F.2d 1402, 1404-05, 17 USPQ2d 1795, 1797-98 (Fed. Cir. 1991) (noting that PTO cannot waive statutory requirements). Moreover, while not law, the Examiner notes that applicants are entitled to rely on the MPEP as the USPTO's interpretation provided that the MPEP is not in conflict with any statutes or rules. See *e.g. In re Portola Packaging, Inc.*, 110 F.3d 786, 42 USPQ2d 1295, 1297-

¹³ See also MPEP §2113.

¹⁴ Applicants' "Remarks" in Applicants' Second Response, Page 7, ¶ 2 & 3.

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98 (Fed. Cir. 1997) (“The MPEP does not have the force and effect of law; however, it is entitled to judicial notice as the agency’s official interpretation of statutes and regulations, provided it is not in conflict with the statutes and regulations.”). The Examiner therefore interprets the language as quoted by Applicants as the USPTO’s interpretation of 35 U.S.C. §113.

23. However a careful review of the objections to the drawings as stated in the First Non Final Office Action will reveal that the drawings objections were made under 37 C.F.R. § 1.83(a)—not 35 U.S.C. §113. Applicants’ arguments with respect to 35 U.S.C. §113 have been considered but are not persuasive.

24. Even if—albeit a big if—Applicants properly traversed the drawing objections, the Examiner cites three independent reasons for his position.

25. First, 37 C.F.R. §1.83(a), states in part:

(a) The drawings in a nonprovisional application *must show every feature* of the invention specified in the claims. However, conventional features ... should be illustrated in the drawing in the form of a graphical drawing symbol or labeled a representation (e.g. a labeled rectangular box).[Emphasis added.]

26. The rule expressly states the “application must show every feature of the invention specified in the claims.” *Id.* It’s the Examiner’s position that this rule is clear on its face. In other words, if its in the claims, it must be shown in the drawings.

27. In fact, even if the element was conventional,¹⁵ 37 C.F.R. §1.83(a) nevertheless requires the features to be shown in the drawings—albeit a graphical drawing symbol or labeled representation. Therefore, arguments that features are old and well known, one of ordinary skill

¹⁵ The Examiner notes the following definition of conventional: “conventional, 2 ... b: lacking originality ... c (1) : ORDINARY, COMMONPLACE” Merriam Webster’s Collegiate Dictionary.

in the art would be able to ascertain the claimed features from the drawings or specification, or that a drawing is not necessary for the understanding of the invention as defined by the claims are not persuasive.

28. In this case, the Examiner will presume (for Applicants' benefit) that all features shown in the figures are *not* conventional. However, if Applicants believe certain features in any claimed method are conventional, the Examiner respectfully requests Applicants to properly delineate such features in their drawings as required. For these reasons alone, Applicants' arguments are unpersuasive.

29. Second, once applicants' application is published or issues as a U.S. patent, it can be used against others as prior art. See e.g. *In re Mraz*, 455 F.2d 1069, 173 USPQ 25, 27 (CCPA 1972) ("Description for the purposes of anticipation can be by drawings alone. . . .") and MPEP §2125. To help ascertain Applicants' invention in their published application or issued patent when it is used against others, drawings are frequently the quickest and easiest form of describing the invention. U.S. patent application numbers 'US 2002/0096320 A1', 'US 2002/00997406 A1', and 'US 2002/0102749 A1' are published applications with 5,395 claims, 6,632 claims, and 6,632 claims respectively!¹⁶ How does an applicant reasonable expect the public to follow and comprehend such applications without a flow chart for the method claims? While Applicants' current application does not contain the number of claims listed above, the reasoning is still the same.

¹⁶ A search reveals that there are over 50 published applications with at least 5000 claims.

30. Theoretically, Applicants in the current application are also free to recite over 6000 claims (although the Examiner *strongly* encourages Applicants *not* to do this). Published patents within class 705 are now routinely issuing with specifications over 100 pages. Whether its 6 claims or 6000 claims, unless the claimed methods are shown in the drawings and preferably in flow chart form, it is extremely difficult to comprehend the invention (for prior art purposes). For this reason alone, such arguments are not persuasive.

31. Finally and to preempt arguments of inherency are also unpersuasive. Many applicants frequently argue that such that features in dependent claims *are already shown* in the drawing since the features found in those dependent claims are subsets of the features found in the independent claims. The argument goes that that if is agreed that all features in the independent claims are shown, features in the dependent claims (which further define the invention) are inherently shown. For example, applicants argue that an independent claim which recites “a network” (which everyone agrees is shown in the drawings as a box with the term “network” around it) inherently discloses a claimed feature found in a dependent claims such as “wherein the network is the Internet” since “network is shown.

32. If applicants were allowed to follow this reasoning, drawings of “systems’ could be illustrated as a single drawing with a single box labeled ‘System’ while method claims could be illustrated with two rectangular boxes in flow chart form labeled ‘Method Steps.’ This line of reasoning clearly defeats the principle purpose of the drawings: “for the understanding of the subject matter sought to be patented.”¹⁷ Furthermore, because issues of how much patentable

¹⁷ 35 U.S.C. 113 (1999).

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weight to give structural limitations in method steps continually arise, Applicants' delineation of what specifically are the steps in their claims is of great importance. And since the drawings are used to help interpret the claims, features missing from the drawings will not necessarily be interpreted as part of the claims. See *e.g. Toro Co. v. White Consolidated Industries, Inc.*, 199 F.3d 1295, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999)(where the court interpreted a claim to exclude a broader interpretation—citing 37 C.F.R. §1.183(a) and MPEP §608.02(d)—because, inter alia, the drawings failed to show such broader structure as required by rule). For this reason alone, such arguments are not persuasive.

Prior Art

33. Applicants' arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

Conclusion

34. References considered pertinent to Applicants' disclosure are listed on form PTO-892.

35. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8th Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8th Edition, August 2001.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

37. Because this application is now final, Applicants are reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1st paragraph written description and enablement, §112 2nd paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.


38. In accordance with *In re Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35, the Examiner finds that the Borland's Paradox for Windows User's Guide is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The reference is cited in its entirety. Paradox for Windows User's Guide exemplifies a typical relational database system.

Because of the reference's basic content (which is self-evident upon examination of the reference) and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that the Paradox for Windows User's Guide is primarily directed towards those of low skill in this art. Because the reference is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within the reference.

39. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicants for their "Remarks" (Paper No. 17 received August 16, 2004, beginning on page 6) traversing the Examiner's positions on various points. If Applicants disagree with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,¹⁸ the Examiner respectfully reminds Applicants to properly traverse the Examiner's position(s) in accordance with 37 C.F.R. §1.111(b) in their next properly filed response. By addressing these issues now, matters where the Examiner and Applicants agree can be eliminated allowing the Examiner and Applicants to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicants have any questions regarding the Examiner's positions or have other questions regarding this communication or

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even previous communications, Applicants are strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer
Primary Examiner
Art Unit 3627

AJF
December 22, 2004

¹⁸ E.g., if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner's implied position that the references are analogous art.